

109



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

| | | | | |
|------------|------------|----------------------------------|---------------|------|
| 09/586,535 | 05/31/2000 | Jean-Christophe Francis Audonnet | 454313-2335.1 | 6015 |
|------------|------------|----------------------------------|---------------|------|

20999 7590 07/12/2004

FROMMER LAWRENCE & HAUG
 745 FIFTH AVENUE- 10TH FL.
 NEW YORK, NY 10151

EXAMINER

LI, QIAN JANICE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1632

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/586,535 | Applicant(s) AUDONNET ET AL. | |
| | Examiner Q. Janice Li | Art Unit 1632 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,13,15-24,28-35,37,39-51 and 54-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,13,15-24,28-35,37,39-51 and 54-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/28/04 has been entered.

The Declaration of Inventors and Remarks filed 2/19/04 have been considered. Claims 12, 13, 15-24, 28-35, 37, 39-51, and 54-66 are pending and under current examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 15-24, 28-35, 37, 39, 40, 42-51, and 54-66 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Poet et al* (US 6,217,883), and *Meehan et al* (J Gen Virol 1998;79:2171-79), in view of *Nabel et al* (US 5,910,488).

In the Remarks submitted 2/19/04, Applicants relied on the attached Katz Declaration attest that Meehan et al publication is not by "others", and asserting the parties of present inventors and authors of the Meehan et al publication worked together on certain aspects of PCV-2.

The argument and declaration have been fully considered but they are not sufficient to overcome the rejection because the Katz declaration is defective as the inventors are not co-authors of the cited *Meehan et al* reference. The Declaration relies on the fact that the *Meehan et al* article acknowledged co-inventors Catherine Charreyre and Jean-Christophe Audonnet. However, it is noted that the Katz Declaration provides "WHERE THE APPLICANT IS ONE OF THE CO-AUTHORS OF A PUBLICATION CITED AGAINST HIS OR HER APPLICATION, THE PUBLICATION MAY BE REMOVED AS A REFERENCE BY THE FILING OF AFFIDAVITS MADE OUT BY THE OTHER AUTHOS ESTABLISH THAT THE RELEVANT PORTIONS OF THE PUBLICATION ORIGINATED WITH, OR EWERE OBTAINED FROM, APPLICANT. SUCH AFFIDAVITS ARE CALLED DISCLAIMING AFFIDAVITS", "THE REJECTION CAN ALSO BE OVERCOME BY SUBMISSION OF A SPECIFIC DECLARATION BY THE APPLICANT ESTABLISHING THAT THE ARTICLE IS DESCRIBING APPLICANT'S OWN WORK. *IN RE KATZ*, 687 F.2d 450, 215 USPQ 14 CCPA 1982" (MPEP 2132.01, emphasis added). In the instant case, since none of the inventors is the co-author of the cited publication, and the declaration is not a disclaiming affidavits, the cited publication is still considered as "by others".

In the Declaration, the inventors also indicated that Catherine Elisabeth Charreyre is a co-inventor of U.S. Patent 6,368,601 along with Meehan et al. However, it is noted that the recited patent is not relied upon in the instant rejection, thus the issue is irrelevant to the instant rejection.

Moreover, it is noted that the provisional application is filed in French. Applicant cannot rely upon the priority papers in foreign language to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. Until such condition is met, the cited *Meehan et al* publication is effective as 102(b) type of reference, and a Katz declaration could not obviate the rejection of record.

Accordingly, for reasons of record and set forth above, the rejection stands.

Claims 13, 18-24, 37, 39, 41, 45-51, 65 and 66 stand under 35 U.S.C. 103(a) as being unpatentable over *Poet et al* (US 6,217,883) and *Meehan et al* (J Gen Virol 1998;79:2171-79), in view of *Mathiowitz et al* (US 6,475,779).

In the response, the arguments for this rejection were combined with the previous rejection, which have been addressed in the immediate preceding section; therefore, for the reasons of record and set forth above, the rejection stands.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Q. Janice Li** whose telephone number is 571-272-0730. The examiner can normally be reached on 9:30 am - 7 p.m., Monday through Friday, except every other Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Amy Nelson** can be reached on 571-272-0804. The fax numbers for the organization where this application or proceeding is assigned are **703-872-9306**.

Any inquiry of formal matters can be directed to the patent analyst, **Dianiece Jacobs**, whose telephone number is (571) 272-0532.

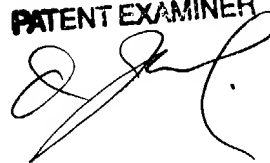
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.


Application/Control Number: 09/586,535
Art Unit: 1632

Page 6

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

JANICE LI
PATENT EXAMINER


Q. Janice Li
Patent Examiner
Art Unit 1632


July 8, 2004